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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,357	06/12/2001	Teruaki Itoh	160-357	2162

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EXAMINER

PATEL, JAYANTI K

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,357

Applicant(s)

ITOH, TERUAKI

Examiner

Jayanti K. Patel

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 5 is/are rejected.
- 7) ☒ Claim(s) 2 and 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/4

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been placed of record in the file.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bacus et al. (US 5,428,690) in view of Ortyn et al. (US 5,499,097).

Regarding claim 1, Bacus discloses a system for automated assay of biological specimens comprising:

a plurality of specimen processing units each having flat sides and a specimen operating surface, the specimen processing units having at a same depth dimension, and the specimen operating surfaces of the specimen processing units having a same height dimension (figure 1, element 12a and figure 1A, elements 104, 105); coupling means for closely coupling right and left sides of the specimen processing units to each other (figure 3, elements 60, 68, 101, 110);

Bacus discloses a stepping motor (figure 4, element 86a) without specific details regarding a single driving control unit.

In the same field of endeavor, however, Ortyn discloses an image collection and evaluation system comprising: a single driving control unit for controlling a related operation of all of the specimen processing units and a single operation of a designated one of the specimen processing units (figure 1A, element 504).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a single driving control unit as taught by Ortyn in the biological specimen processing system of Bacus because Ortyn ensures the priority of the low power scan are appropriately positioned under a high power objective for image collection. Additionally, the system of Ortyn ensures repeatability and accuracy of the motion system.

4. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacus et al. (US 5,428,690) in view of Ortyn et al. (US 5,499,097) as applied to claim 1 above and further in view of Kowallis (US 6,355,487).

As to claims 4-5, while Bacus and Ortyn are silent about specific details regarding mechanical, magnetic and pneumatic coupling, Kowallis discloses a system for transferring small biological specimens comprising mechanical, magnetic and pneumatic coupling (column 8, lines 58-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use coupling means as taught by Kowallis in the biological specimen processing system of Bacus because the system of Kowallis delivers micro-volume of a substance in a quick and efficient manner and is relatively

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easy to use. Additionally, the coupling means similar to that of Kowallis are well known and are routine used where a precision motion controlled is required.

Allowable Subject Matter

5. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 3 being dependent on claim 3, is objected for the same reasons.

Other prior art cited

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Price et al (US 5,548,661) discloses a operator independent image cytometer (Figure 1).

Akamatsu et al. (US 4,363,781) discloses a discrete type automated chemical analysis system.

Fleck (US 5,699,794) discloses a system for automated urine sediment sample Handling (figure 1).

Kamentsky (US 5,587,833) discloses a computerized microscope specimen encoder.

Margrey et al. (US 5,366,896) discloses a robotically operated medical laboratory system.

Contact information

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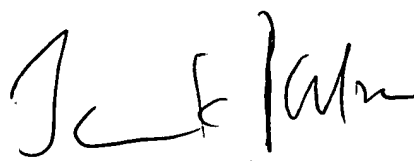
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jayanti K. Patel whose telephone number is (703) 308-7728. The examiner can normally be reached on Monday-Friday (7:00-4:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (703) 308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JKP

April 22, 2004



Jayanti K. Patel
Primary Examiner